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10/043,416	04/19/2002	Denise Renee Murray		9178

7590

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Denise R. Murray  
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EXAMINER

KING, ANITA M

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 09/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/043,416

Applicant(s)

MURRAY, DENISE RENEE

Examiner

Anita M. King

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

This is the first office action for application number 10/043,416, Edge-It, filed on April 19, 2002.

### **Mini Lecture**

#### **Information to Pro Se Inventors Regarding responses to Office Actions**

### **INTRODUCTION**

An examination of this application reveals that applicant may be unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed.

Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application. The value of a patent is largely dependent upon skillful preparation and prosecution. Although the services of a registered patent attorney or agent is advised, the Office cannot aid in selecting an attorney or agent. 37 C.F.R. § 1.31; M.P.E.P. § 401. However, Applicant is encouraged to peruse the publication entitled "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

### **DISCUSSION**

The following discussion provides general information for Applicant's benefit regarding an applicant's response, new matter, the period for response, and the certificate of mailing.

*I. Response by Applicant*

The applicant MUST respond to every ground of rejection and objection made in an Office action. 37 C.F.R. § 1.111. The applicant will generally present arguments that the examiner's rejections or objections were made in error; or amend the specification, drawings, and/or claims to overcome the rejection or objection. Amendments to the application may not introduce new matter. 37 C.F.R. § 1.118.

Unless the Office explicitly requests the return of a paper, all papers mailed to the applicant are intended to be kept by the applicant for his own records. The response must be signed by ALL applicants. 37 C.F.R. § 1.33.

*A. Arguments*

Should the applicant disagree with the examiner's position, the applicant should distinctly and specifically point out the supposed errors in the examiner's action with arguments under the heading "Remarks" in the response. 37 C.F.R. § 1.111. In addition, the applicant must discuss the references cited by the examiner that explain how the claims avoid the references or patentably distinguish from them. Id.

*B. Amendments to the Specification*

An amendment to the specification may remove a rejection or objection. Any amendment to the specification must be presented as a list of additions and deletions, referring to the passages in question by page and line numbers. 37 C.F.R. § 1.121.

An amendment to the specification should appear as follows:

On page 16, line 12, change "effect" to --affect--.

On page 23, line 4, insert --bucket-- after "backhoe".

Any language that is being inserted in to the specification should be placed between double dashes.

It is not necessary to submit a new specification unless one has been required by the Examiner.

### C. Amendments to the Claims

An amendment to the claim may remove a rejection or objection. Amendments to the claims should be presented in the format described above for amendments to the specification. 37 C.F.R. § 1.119. However, if the amendment to a claim requires the addition of more than five words, the claim should be completely rewritten with the additions to the claim being underlined. *Id.* Any deletions from the claims should be enclosed in brackets (brackets "[" and "]", not parentheses "(" and ")"). *Id.* Parenthetical information is provided after the claim number to indicate how many times the claim has been amended (e.g., "(Once Amended)", "(Twice Amended)", etc.).

For example, if a claim to a chair was originally written:

1. A chair comprising a horizontal seat, a vertical back, and a plurality of vertical support members.

An amended version of this claim might then be written as follows:

1. (Once Amended) A chair comprising a horizontal seat, a vertical back, and [a plurality of] four vertical [support members] legs attached to said seat.

In this example, the words "a plurality of" and "support members" have been deleted from the claim. The words --four-- and --legs attached to said seat-- have been inserted.

#### D. Drawing Corrections

Finally, correction of the drawings may remove a rejection or objection. Changes to the drawings are submitted as proposed drawing corrections and can be made only with permission of the Office. 37 C.F.R. § 1.123. Proposed drawing corrections should be filed with the response, but should be a separate paper. M.P.E.P. § 608.02(r). The proposed corrections should appear in red ink in the drawings. M.P.E.P. § 608.02(v).

#### *II. New Matter*

As previously mentioned, no amendment to the specification, claims, or drawings may introduce new matter. 37 C.F.R. § 1.118. "New matter" constitutes any material which meets the following criteria:

- (1) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- (2) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

See M.P.E.P. § 706.03(o). For example, in the amendment to the claim discussed above, the new limitation of "four legs" would not constitute new matter if the specification or drawings originally described the inclusion of four legs on the chair.

#### *III. Period For Response*

An Office action generally sets a time period in which the applicant has to respond to every rejection and objection (called a shortened statutory period). 37 C.F.R. § 1.134. This time period for response appears on the cover letter (form PTO-

326) of the Office action. Usually, a 3 month shortened statutory period is set.

M.P.E.P. § 710.02(b). The applicant's response must be received within the time period listed on the cover letter, or the application will be held abandoned. 37 C.F.R. § 1.135.

Currently, the Office allows the time period for response to be extended past the shortened statutory period up to a maximum of 6 months (called the maximum 6 month statutory period). In order to extend the period of response past the shortened statutory period, a request for an extension of time and payment of the appropriate fee is required. 37 C.F.R. § 1.136. The request must state that it is for "an extension of the period for response under 37 C.F.R. § 1.136(a)." The following table lists the required fees for extensions of the shortened statutory period:

Months Past Response Date	Fee Due (Small / Large Entity)
Response within Time Allowed	None / None
1	\$55/ \$110
2	\$200/ \$400
3	\$460/ \$920
4	\$720/ \$1,440
5	\$980/ \$1,960

It is important to note that no extension of time is permitted that extends the period for response past the maximum 6 month statutory period. Responses received after the maximum 6 month statutory period will be held abandoned. 37 C.F.R. § 1.135.

Three examples are provided:

Example 1:

A complete response is filed four months and one day after the mailing date of an Office action. The Office action sets a 3 month shortened statutory period for response. The response must be accompanied by a fee in the amount of \$200 (for a small entity; \$400 for a large entity) for a 2 month extension of time. The response must also contain a statement requesting "an extension of the period for response under 37 C.F.R. § 1.136(a)."

Example 2:

A complete response is filed five months and one day after the mailing date of an Office action. The Office action sets a 2 month shortened statutory period for response. The response must be accompanied by a fee in the amount of \$755 (for a small entity; \$1,510 for a large entity) for a 4 month extension of time. The response must also contain a statement requesting "an extension of the period for response under 37 C.F.R. § 1.136(a)."

Example 3:

A complete response is filed six months and one day after the mailing date of an Office action. The Office action sets a 3 month shortened statutory period for response. The response is held abandoned even if accompanied by a fee and a request for an extension of time. Remember, extensions of time may not be used to extend the period for response past the maximum 6 month statutory period. 37 C.F.R. § 1.135.

#### *IV. Certificates of Mailing or Transmission*

It appears that the applicant in this application is a *pro se* applicant (an inventor filing the application alone without the benefit of a Patent Attorney or Agent). Applicant may not be aware of the preferred methods of ensuring timely filing of responses to



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communications from the Office and may wish to consider using the Certificate of Mailing or the Certificate of Transmission procedures outlined below.

### CERTIFICATE OF MAILING

To ensure that the Applicant's response is considered timely filed, it is advisable to include a "Certificate of Mailing" on at least one page (preferably on the first page) of the response. This "Certificate" should consist of the following statement:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: "Commissioner of Patents and Trademarks, Washington, D.C. 20231" on (Date of Deposit).  
(Typed or printed name of person signing this certificate)

(Signature)

### CERTIFICATE OF TRANSMISSION

Alternatively, if the applicant wishes to respond by facsimile rather than by mail, another method to ensure that the Applicant's response is considered timely filed, is to include a "certificate of transmission" on at least one page (preferably on the first page) of the response. This method should be used by foreign applicants without access to the U.S. Postal Service. This "certificate" should consist of the following statement:

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) \_\_\_\_\_ - \_\_\_\_\_ (date).  
(Typed or printed name of person signing this certificate)

(Signature)

These "Certificates" may appear anywhere on the page, and may be handwritten or typed. They MUST be signed, and the date must be the actual date on which it is mailed or transmitted. For the purpose of calculating extensions of time, the date shown on the certificate will be construed as the date on which the paper was received by the Office, regardless of the date of the U.S. Postal Service actually delivers the response, or the fax is "date-stamped" in. In this way, postal or transmission delays do not affect the extension-of-time fee.

In the event that a communication is not received by the Office, applicant's submission of a copy of the previously mailed or transmitted correspondence showing the **originally** signed Certificate of Mailing or Transmission Statement thereon, along with a statement from the person signing the statement which attests to the timely mailing or transmitting of the correspondence, would be sufficient evidence to entitle the applicant to the mailing or transmission date of the correspondence as listed on the Certificate of Mailing or Transmission, respectively.

**NOTICE TO APPLICANT:** In the case of lost or late response the use of other "receipt producing" forms of mailing a correspondence to the Patent Office, such as Certified Mail, or private shippers such as FedEx, **WILL NOT** result in the applicant getting the benefit of the mailing date on such receipts. These receipts are not considered to be acceptable evidence since there is nothing to "tie-in" the receipt with the particular document allegedly submitted.

Furthermore, Applicant is encouraged to include with the response a self addressed and stamped postcard completely itemizing the papers submitted with applicant's response. See M.P.E.P. § 503. When the response is received by the Office, the postcard is date-stamped and returned to the applicant. *Id.* This is an applicant's best indication of the date the Office received the response and if all of the papers submitted have been received.

#### CONCLUSION AND CAVEAT

The above discussion is not intended to be an exhaustive list of all the topics that may be relevant to this particular Application. The information was provided to

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familiarize Applicant with the portions of a response that have historically caused problems for pro se inventors.

Furthermore, even if Applicant's response is in accordance with the information provided above, there is no guarantee that every requirement of the patent laws (35 U.S.C. §§ 1-376), patent rules (37 C.F.R. §§ 1.1-150.6), and Patent Office policy (M.P.E.P. §§ 101-2591) has been met. The adequacy of a response is determined on a case-by-case basis. See 37 C.F.R. § 1.111; M.P.E.P. § 714.02.

## **Detailed Office Action**

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure. **See the term "said" in line 3.**

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following titles are suggested examples: --Forearm Edge Support-- or --Forearm Edge Rest--.

The use of the trademark PLEXIGLAS has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: "Injection," "Said," "Neoprene," and "Allowing," in lines 4, 6, 8, 9, 11, 14, 16, and 17, respectively, should be changed to --injection--, --said--, --neoprene--, and --allowing--; and in line 18, a period --.-- should be inserted after "product". Appropriate correction is required.

The applicant has submitted a product-by-process claim. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production (i.e., the process of injection molding, cited in line 4 of the claim). If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

***Claim Rejections - 35 USC § 112***

Claim 1 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Claim 1 recites the limitations "the front opening" in line 6 and "the base" in line 7. There is insufficient antecedent basis for these limitations in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,554,039 to James. James discloses a plastic padded channel for slipping over an edge of a box-like structure, however capable of slipping over an edge of a standard folding table for supporting a wrist or forearm of a user, comprising: an extruded one piece U-shaped channel (10) of a predetermined thickness, size, and length; the channel having a narrower dimension at the front

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opening opposed to a wider opening at the base of the channel; the channel can be easily slipped on and off the edge; wherein all exterior faces of the channel are incased with a continuous wrap (12) of a predetermined dimension and wherein the wrap is bonded to the channel (Col. 2, line 28ff) by a quick drying cement; wherein the wrap is constructed of a foam rubber.

James discloses the claimed invention except for the limitations of the wrap or pad being neoprene, the channel and the pad being 3/16" thick, and the pad being an alternative color. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the pad in James to have been neoprene for the purpose of providing an alternative mechanically equivalent material for constructing the pad based on its suitability for the intended use. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the dimensions of the pad and channel and the color of the pad for the purpose of providing a different aesthetic appearance to the channel and pad and since such a modification would not have produced any unexpected results.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 1,620,933 to Wilcox

U.S. Patent 1,878,850 to Hilgers

U.S. Patent 3,950,793 to Adams

U.S. Patent 4,703,531 to Bissett

U.S. Patent 5,208,084 to Rutz

U.S. Patent 5,639,072 to McCall

U.S. Patent 6,019,336 to Havens

U.S. Patent 6,116,162 to Santa Cruz et al.

U.S. Patent 6,378,831 to Copland, Jr.

Wilcox discloses a casing protection having a C-shaped channel section covered with a soft protective material. Hilgers discloses a protective device for a table having a U-shaped channel member. Adams discloses a stand having planar member constructed of PLEXIGLAS. Bissett discloses a padded rail cap having a metal channel member covered with a padded material. Rutz discloses an edge pad for attachment to an edge of a desk. McCall discloses a bumper that can be releasably attached to planar edges of furniture, such as a table. Havens discloses a corner cushion having a neoprene cushion for attachment to an edge of a planar surface. Santa Cruz et al. disclose a protective bumper and placemat. Copland, Jr. discloses an air-guard corner and edge protector for a table.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita M. King whose telephone number is (703) 308-2162. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie A. Braun can be reached on (703) 308-2156. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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308-3597 for regular communications and (703) 308-3519 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

  
Anita M. King  
Primary Examiner  
Art Unit 3632

September 5, 2002